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Paper No. 37
Entered: June 6, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
Petitioner,

v.

M2M SOLUTIONS LLC,
Patent Owner.

Case IPR2017-01891
Patent 8,504,007 B2

Before KARL D. EASTHOM, DAVID C. MCKONE,
and STACY B. MARGOLIES, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Amazon.com, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") to institute an *inter partes* review of claims 1–30 of U.S. Patent No. 8,504,007 B2 (Ex. 1001, "the '007 patent"). M2M Solutions LLC ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp."). Pursuant to 35 U.S.C. § 314, in our Institution Decision (Paper 8, "Dec."), we instituted a trial as to claims 1–30. Patent Owner filed a Patent Owner's Response (Paper 19, "PO Resp."), Petitioner filed a Reply to the Patent Owner's Response (Paper 22, "Reply"), and Patent Owner filed a Sur-Reply (Paper 26, "Sur Reply"). We held an oral argument on November 6, 2018, in this proceeding and related proceedings IPR2017-01892 and IPR2017-01893. Paper 30 ("Tr."). On February 7, 2019, we issued a Final Written Decision (Paper 32, "FWD") concluding that each of claims 1–30 is unpatentable as obvious.

On March 8, 2019, Patent Owner filed a Request for Rehearing of our FWD (Paper 33, "Req."), contending that we applied an improper claim construction in our FWD and that, under its proposed claim construction, the claimed subject matter would not have been obvious.

Subsequent to the Request for Rehearing, we invited the parties to file simultaneously supplemental claim construction briefs addressing the claim terms Patent Owner alleges we construed incorrectly. Paper 34. Pursuant to this authorization, Patent Owner filed an Additional Claim Construction Brief (Paper 35, "PO CC Br.") and Petitioner filed a Claim Construction Brief (Paper 36, "Pet. CC Br.").

II. ANALYSIS

The burden of showing that the FWD should be modified is on Patent Owner, the party challenging the FWD. *See* 37 C.F.R. § 42.71(d). In addition, "[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply." *Id.*

In the FWD, we addressed the constructions of the following claim terms recited in the challenged claims via independent claims 1 and 20, at issue in the Request for Rehearing:

> the remote computer server platform being configured to communicate, based upon the results of processing at least some of the received consumer usage information, one or more management instructions that cause the stored data content files of one or more of the plurality of consumer device assets to be automatically modified (claim 1);

and

> the remote computer server platform being configured to communicate, based upon the results of processing at least some of the received consumer usage information, one or more management instructions that cause the stored data content files of one or more of the first and second pluralities of consumer device assets to be automatically modified (claim 20).

FWD 16–18. In particular, as to both of these terms, we ruled that "this limitation should be given its ordinary meaning, i.e., the communication of management instructions, not the management instructions themselves, is based upon the results of processing consumer usage information." *Id.* at 18. Under this construction, we concluded that Kloba (Ex. 1015, US 6,421,717 B1) teaches these claim terms. *Id.* at 43–48, 58.

In the Request for Rehearing, Patent Owner argues that the parties and the Board agreed that these terms should be construed to mean that the management instructions themselves, rather than the communication of those instructions, be based upon the results of processing the consumer usage information. Req. 2–5. Patent Owner contends that Petitioner introduced the construction that we adopted for the first time at the oral argument. *Id.* at 6–7. Patent Owner argues that we should have disregarded Petitioner's proposed construction in favor of the allegedly agreed construction because Patent Owner was not afforded a fair opportunity to respond to Petitioner's proposed construction. *Id.* at 8–15. For example, Patent Owner argues that it "was never provided a meaningful opportunity to address Petitioner's and the Board's new claim interpretation since Petitioner's belated claim interpretation was only offered for the first time at the oral hearing." *Id.* at 13. Patent Owner argues that, under the allegedly agreed construction, Kloba does not teach the above-quoted claim limitations. *Id.* at 15. Patent Owner requests that we modify our decision to adopt its proposed claim constructions and, accordingly, reverse our unpatentability determination. *Id.*

In our Final Written Decision, we explained that Petitioner, although it did not provide its proposed construction expressly, nevertheless provided it implicitly in the Petition through its application of the claim terms. FWD 17; *see also* Pet. 33 ("In order to load a device with user-selected channels, the server must necessarily compile and send instructions to the devices based on processing at least some of the user's selection of those channels and user-identified preferences ('consumer usage information')."); FWD 44 ("Citing to Dr. Kesidis's testimony, Petitioner argues that . . .

Kloba's server must necessarily compile and send instructions to the device."). In our Order authorizing additional claim construction briefing, we reiterated this point, and further noted that we did not, at any point, agree with or adopt Patent Owner's proposed construction, nor did Petitioner. Paper 34, 4. Nevertheless, we authorized additional claim construction briefing to ensure that we have heard and have had an opportunity to consider the parties' claim construction arguments fully. *Id.* at 4–5.[1] We now revisit the constructions of the above-quoted claim terms in light of the complete record, including the parties' new briefs. Nevertheless, we conclude that the constructions in our Final Written Decision were correct.

As explained in the Final Written Decision, we apply a broadest reasonable construction. FWD 8–9. "Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history." *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016).

Petitioner contends that the meaning of the claim language is straightforward and that, in claim 1, for example, the phrase "based upon the results of processing at least some of the received consumer usage information" modifies the verb "communicate." Pet. CC Br. 1–2. Thus, according to Petitioner, "[i]t is the *act of communicating* that is based on the results of processing the information." *Id.* at 2.

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[1] Petitioner contends that Patent Owner waived its arguments regarding the claim terms disputed in its Request for Rehearing by not proposing formal constructions of the full terms as we reproduce them above. Pet. CC Br. 4–7. This argument is unpersuasive, as we expressly authorized both parties to brief explicitly an issue that both parties' prior arguments addressed implicitly. Paper 34, 3–5.

Patent Owner contended in its Response, without further explanation, that "the express claim language requires 'management instructions' that are '***based upon the results of processing at least some of the received consumer usage information***.'" PO Resp. 31. Similarly, in its Request for Rehearing, Patent Owner argues that the parties and the Board agreed on a construction and that "independent Claims 1 and 20 were interpreted to require 'management instructions' that are 'based upon the results of processing at least some of the received consumer usage information' according to the plain language of the claims." Req. 2–3. Nevertheless, in its supplemental claim construction brief, Patent Owner offers a new and different proposed construction:

> a [person of ordinary skill in the art] would understand the ordinary and customary meaning of the "management instructions" claim elements as being that **the server's determination to communicate the claimed management instruction(s) in particular as part of a transmission sent to at least one consumer device asset is what needs to be "based upon the results of processing at least some of the received consumer usage information."** In other words, these claim elements require that the decision by the server to include the particular claimed management instruction(s) within a transmission sent for purposes of causing resulting asset modifications is what must be predicated upon the claimed processing.

PO CC Br. 4. Patent Owner argues that its new proposal is based on language in the '007 patent "which explicitly delineates that the server's determination to 'communicate. . . [the claimed] management instructions' themselves as part of a subsuming transmission is what has to be 'based upon the results of processing at least some of the received consumer usage information.'" *Id.* at 4–5 (brackets supplied by Patent Owner). It is unclear

how Patent Owner's new proposal differs from Petitioner's. Patent Owner now contends that the decision to communicate management instructions is based on processing consumer usage information while Petitioner contends that the communication of management instructions is based on processing consumer usage information. The competing constructions now appear to be the same materially because the communication implies a decision to communicate.

In any case, we agree with Petitioner that the language of the claims is clear. As we stated in the Final Written Decision, according to the plain language of claims 1 and 20, it is the communication of management instructions, not the management instructions themselves, that is based upon the results of processing at least some of the received consumer usage information. FWD 17–18. We maintain that conclusion here. The natural reading of the claim language is that "based upon the results of processing at least some of the received consumer usage information" modifies "communicate."

Patent Owner argues that its new proposal follows from the claim language of related patents challenged concurrently in two other *inter partes* reviews. PO CC Br. 5. Specifically, Patent Owner contends that the claims of the three related patents (the '007 patent, US 8,577,358 B2 ("the '358 patent"), and US 8,577,359 B2 ("the '359 patent)) in the three related proceedings (the instant proceeding, IPR2017-01892, and IPR2017-01893) "should be accorded the same claim scope as one another," and "[a]ccordingly, the observations that Patent Owner offers . . . regarding any one of these particular claim elements are intended to apply equally to all of them." *Id.* at 1. Patent Owner then argues that the constructions of the

disputed claim terms of the '007 patent should follow from the claim language of similar terms of the '358 and '359 patents. *Id.* at 5–6. According to Patent Owner, the similar claim language of the '358 patent requires that the management of the device assets be based upon the results of processing consumer usage information and that the similar claim language of the '359 patent requires that the management instructions themselves be predicated upon the processing. *Id.* at 5. According to Patent Owner, a skilled artisan "would recognize that where the recited 'management instructions' are themselves predicated upon the claimed processing, the server's determination to communicate those instructions to the assets would also necessarily be predicated upon the claimed processing." *Id.* at 5–6. This argument appears to be in support of the construction proposed in the Patent Owner Response, but not the new construction proposed in Patent Owner's Supplemental Claim Construction Brief. Thus, it is unclear which construction Patent Owner would apply in this proceeding or how it differs from that proposed by Petitioner. However, Patent Owner offers no authority for the premise that we may disregard the actual language of the claims of the patent at issue in this proceeding in favor of the language used in claims of related patents.

In sum, the plain language of claims 1 and 20 is clear. The communication of the management instructions is based on processing received consumer usage information. The Federal Circuit has held

> [w]hen claim language has as plain a meaning on an issue as the language does here, leaving no genuine uncertainties on interpretive questions relevant to the case, it is particularly difficult to conclude that the specification reasonably supports a different meaning. The specification plays a more limited role

> than in the common situation where claim terms are uncertain in meaning in relevant respects.

Straight Path IP Grp., Inc. v. Sipnet EU S.R.O., 806 F.3d 1356, 1361 (Fed. Cir. 2015). There is no uncertainty in the plain language of the claim terms at issue on rehearing. Moreover, we explained in the Final Written Decision why the specification supports our construction. FWD 18. Nevertheless, we address Patent Owner's arguments that the specification requires a construction different from that which we adopted in the Final Written Decision.

Patent Owner argues that several examples in the '007 patent show that "the server's determination about what modifications to make to its managed device assets, and thus what 'management instructions' to send them for purposes of effectuating such modifications, is based upon the results of processing various types of information that the server has first received from the device assets themselves." PO CC Br. 2–3 (citing Ex. 1001, 4:14–20, 6:60–7:2, 8:29–41). Patent Owner does not contend that any of these examples is in the context of consumer usage information. Rather, Patent Owner contends that these are examples in which the specification "broadly teaches that the means by which the remote computer server platform causes modifications to various aspects of its managed device assets is by sending wireless 'management instructions' (aka, 'data instructions,' 'management commands,' 'commands')" and that "these teachings are fully applicable to scenarios in which the managed assets would qualify as examples of the claimed 'consumer device assets.'" *Id.* at 1–2.

According to the first example,

> in an instance where a security guard is alerted and wishes to secure a monitored area, it would be beneficial if a mobile phone message could be received by a remote server and cause data instructions to be communicated to one or more wireless control modules which might lock doors remotely or disable the functionality of certain devices.

Ex. 1001, 4:14–20. Here, if the "mobile phone message" is consumer usage information and "data instructions" are considered management instructions, those management instructions are communicated based on processing consumer usage information. This is consistent with the construction in the Final Written Decision. FWD 18 (noting that this passage is an example of communication of instructions based on processing data).

In the next example, the specification provides the following:

> It is a further object of the present invention to provide an improved remote asset management system, which comprises a remote server that is pre-programmed to receive and process subscriber number information and or IP address identification and GPS coordinate information from each of a plurality of wireless modules wherein following processing of the received data from a specific wireless module, the server may determine that a data message is to be sent to the specific module which causes a change in the operational status of the wireless module and or associated asset.

Ex. 1001, 6:60–7:2. Patent Owner argues that, in this passage, the "server processes GPS location information received from [the] asset as its basis for determining what modifications to cause to [the] asset's operational status by way of including effectuating management instructions in wireless data messages." PO CC Br. 2–3. However, assuming that the "received data" is consumer usage information and the "data message" includes management instructions, all this passage actually says is that those management

instructions are sent based on processing consumer usage information. It does not expressly describe basing the management instructions themselves on processing of the consumer usage information.

In the next example, the '007 patent states the following:

> It is a further object of the present invention to provide an improved remote asset management system for facilities management, which comprises the means for remotely monitoring access to a building or enclosed area and communicating the presence and or movement of any persons within the monitored facilities to a remotely located server either independently or in response to status monitoring requests. Furthermore, according to changes in the data values generated by the said facilities management system, the server may consequently generate one or more alarm conditions and communicate data messages to security personnel and or security control centres and or systems controlling doors and barriers which allow access to the said facilities.

Ex. 1001, 8:29–41. Patent Owner characterizes this passage as describing that a "server processes intruder alarm information received from [a] security system asset as its basis for determining what modifications to cause to [the] asset's control over 'doors and barriers' by way of including effectuating management instructions in wireless data messages." PO CC Br. 3. In this passage, there is no express disclosure that management instructions, as opposed to the communication of such instructions, are based on processing consumer usage information, and Patent Owner does not clearly contend otherwise. As noted in the Final Written Decision, an additional example from the specification also supports the plain meaning of the claim terms. FWD 18 (citing Ex. 1001, 22:47–57).

None of Patent Owner's cited examples clearly describes management instructions that are based on processing consumer usage information. At

best, Patent Owner infers that instructions communicated as a result of processing certain information are based on that information because they effectuate a change consistent with that information. On the other hand, many of these passages directly support the construction in the Final Written Decision. In any case, nothing in these examples suggests a definition that would support a requirement that management instructions themselves be based on processing consumer usage information. Likewise, none of these examples precludes a construction consistent with the plain language of the claims, in which the communication of management instructions is based on processing consumer usage information.

Patent Owner also cites to the Abstract of the '007 patent, which states as follows:

> Based upon the results of processing at least some of the received consumer usage information, the remote computer server platform manages the consumer device assets by communicating management instructions that cause the stored data content files of one or more assets to be automatically modified.

PO CC Br. 5. Patent Owner argues that the Abstract "describes the server making determinations about 'communicating management instructions' themselves to the assets as the means by which it 'manages' the assets 'based upon the results of processing at least some of the received consumer usage information.'" *Id.* We agree with Patent Owner's characterization but conclude that it supports the construction in the Final Written Decision rather than the construction Patent Owner proposed in its Response.

As explained in the Final Written Decision, Patent Owner points to only one example in the specification of consumer usage information. FWD 11–12 (noting Patent Owner's citation to Ex. 1001, 3:55–65, and the

additional disclosure of that example at 10:59–11:3). Patent Owner, in its supplemental claim construction brief, again directs us to this passage and argues that it implicitly describes management instructions based on processing consumer usage information. PO CC Br. 3–4. This passage does not expressly describe management instructions or their relationship to consumer usage information. However, even if Patent Owner is correct that it is disclosed implicitly, nothing in this disclosure redefines the claim language or precludes a construction consistent with its ordinary meaning. In sum, the specification provides ample support for the construction in the Final Written Decision, but not the construction Patent Owner proposed in its Response.

Patent Owner also argues that a Magistrate Judge in District Court construed the disputed claim limitations consistent with Patent Owner's proposal in its Response. PO CC Br. 6 (citing *M2M Sols. LLC v. Amazon.com, Inc.*, 2017 U.S. Dist. LEXIS 203110, *22 n. 5, *23, *30 (D. Del. Dec. 11, 2017) (Ex. 2026)). As noted above, Patent Owner now advances a proposal different from that which it advanced in the Response (and more closely aligned with Petitioner's proposal). Thus, it is not clear whether Patent Owner continues to pursue its earlier proposal. Nevertheless, the Magistrate Judge was ruling on subject matter eligibility at the pleading stage, and there is no indication that the claim limitations at issue here were, at that point, contested or meaningfully argued. *See M2M Sols.*, 2017 U.S. Dist. LEXIS 203110, at *1. Thus, the statements in the Magistrate Judge's decision do not persuade us to depart from the claim language and the specification.

In sum, we are persuaded that the plain language of the claims and the description in the specification support the constructions we adopted in the Final Written Decision.

At the end of its supplemental claim construction brief, Patent Owner attempts to re-argue the validity of its claims under the new construction it proposes in the brief. PO CC Br. 7. In particular, Patent Owner now argues that Kloba's determination to communicate delta instructions is not based on the results of processing consumer usage information. *Id.* This is inconsistent with its Response and Sur-Reply, in which Patent Owner argued that the deltas themselves were not based on the results of processing consumer usage information. PO Resp. 31, 39; Sur-Reply 6–7. As noted in our Order authorizing additional claim construction briefing, however, Patent Owner did not request an opportunity to present additional patentability arguments under the claim constructions we adopted. Paper 34, 4 n.1. Likewise, Patent Owner did not request an opportunity to present additional patentability arguments under its new proposed construction, which is similar to the construction we adopted. Our Order did not authorize such additional arguments. Accordingly, Patent Owner has waived its new patentability arguments.

In any case, we addressed these limitations under the construction we adopted in the Final Written Decision, which is close to Patent Owner's new construction, and found them taught by Kloba. FWD 43–48. Specifically, we found that Kloba's figures 1I1 and 1X, and the corresponding description, showed that all instructions and objects, including the deltas (differences between objects currently in a client's database and objects offered by content providers), are transmitted from the server to the client in

one transmission during a synchronization, and that this transmission is based, in part, upon the results of processing the information collected through the interfaces of Figures 12 and 17. *Id.* at 44–46 (citing Ex. 1015, 8:7–19, 19:47, 19:51–25, 20:50–56; Pet. 32–33; Reply 6–7). We rejected Patent Owner's argument that deltas were communicated separately from other synchronization information. *Id.*

According to Patent Owner, "[t]he determination by Kloba's server to communicate 'deltas' instructions by including them in a one-down synch transmission is in no sense based upon the results of its processing of Petitioner's alleged 'consumer usage information.'" PO CC Br. 7. According to Kloba, however:

> Synchronization modules 155 synchronize the deltas from client 108 with providers 128 (step 172C). Based on the information from providers(s) 128, synchronization modules 155 compile instructions to synchronize the client 108 with providers 128 (step 172D). Synchronization module 155 sends such instructions to client 108, plus updated data marker (step 172E).
>
> Note this is the only transmission from the server 104 to the client 108 during the synchronization process. Thus the invention achieves a one-up/one-down synchronization process, thereby improving performance.

Ex. 1015, 20:11–21. We found that this teaches communicating management instructions "based upon the results of processing at least some of the received consumer usage information," as recited in claim 1. FWD 46 ("The server communicates its single set of instructions to the client as a result of processing all of the information it receives in the single-up transmission from the client. This includes deltas, requests for new channels, and changes to preferences."); *see also* Ex. 1015, 8:7–19. This

finding applies equally under Patent Owner's new proposed construction, namely, "the server's determination to communicate the claimed management instruction(s) in particular as part of a transmission sent to at least one consumer device asset is what needs to be 'based upon the results of processing at least some of the received consumer usage information.'" PO CC Br. 4 (emphasis omitted). Specifically, the decision to communicate synchronization information (including deltas and new channels) from the server to the client is based, in part, on the server's synchronization of the client's channel information (including deltas and new channels) with the providers of the channels, which involves processing the requests for new channels and changes to preferences. Ex. 1015, 8:7–19, 20:1–21. Thus, Kloba and Multer (US 6,671,757 B1, Ex. 1016) render claims 1 and 20 obvious even under Patent Owner's new proposed construction.

III. CONCLUSION

Patent Owner does not show that we misapprehended or overlooked any of its arguments or evidence or that we incorrectly construed any claim term.

IV. ORDER

Patent Owner's Request for Rehearing is denied.

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